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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,170	03/24/2000	Yoram Levanon	1268-094	2252

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EXAMINER

RETTA, YEHDEGA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/534,170	Applicant(s) LEVANON ET AL.	
	Examiner Yehdega Retta	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 22-29 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 22-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to after final argument filed October 28, 2005. Applicant canceled claim 30. Claims 1-13 and 22-29 are currently pending. Applicant's request for reconsideration of the finality of the rejection of the last Office action is considered and, therefore, the finality of that action is withdrawn.

Declaration

The Declaration under 37 CFR 1.132 filed April 4, 2004 is insufficient to overcome the rejection of claims 1-13 and 22-29 based upon 35 U.S.C. 103(a) as set forth in the last Office action because: Applicant failed to establish a nexus between the claimed invention and evidence of commercial success.

Applicant submitted English translation of abbreviated research reports as a declaration under 37 C.F.R § 1.132. Applicant indicates that the research shows a significant increase in success rate when a telemarketing center used the method claimed in the instant application in its marketing campaign to sell a teen magazine. Applicant indicates that the project provides an exceptionally good result (16% success rate) compared to the convention marketing methods (8-10% success rate). Applicant also indicates another research report shows a significant increase (144) in success rate when a telemarketing center used to sell software. Applicant further indicates that the inventive method provides an exceptional good result (66% success rate for the 42-people group) compared to the conventional marketing method.

Evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. The personal opinion of the applicant as to nexus is

Art Unit: 3622

insufficient; there must be some evidence showing that the customer bought the device because of features of the claimed invention. *In re Huang*, 100 F.3d 1568 (Fed. Cir. 1996).

Proof of commercial success, however, is not simply a matter of producing sales figures. Applicant must show evidence of market share, growth in market share, and replacement of earlier sales by others. Evidence of commercial success can be downgraded where there is no showing that the sales represent a substantial share of any definable market or that the profitability is anything out of the ordinary in the industry involved. Sales figures cannot be given controlling weight in determining the effect of commercial success where the patent owner was the market leader well before the introduction of the patented invention. Sponsorship by a market leader may be largely responsible for the success of the invention.

716.03 [R-2] Commercial Success

I. NEXUS BETWEEN CLAIMED INVENTION AND EVIDENCE OF COMMERCIAL SUCCESS REQUIRED

An applicant who is asserting commercial success to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of commercial success.

The term “nexus” designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988).

II. COMMERCIAL SUCCESS ABROAD IS RELEVANT

Commercial success abroad, as well as in the United States, is relevant in resolving the issue of nonobviousness. *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

716.03(a) [R-2] Commercial Success Commensurate in Scope With Claimed Invention

I. EVIDENCE OF COMMERCIAL SUCCESS MUST BE COMMENSURATE IN SCOPE WITH THE CLAIMS

Objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. In *re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam “cups” used in vending machines was not commensurate in scope with claims directed to thermoplastic foam “containers” broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229, 17 USPQ2d 1257, 1260 (D.D.C. 1990), *aff’d*, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.).

An affidavit or declaration attributing commercial success to a product or process “constructed according to the disclosure and claims of [the] patent application” or other equivalent language does not establish a nexus between the claimed invention and the commercial success because there is no evidence that the product or process which has been sold

Art Unit: 3622

corresponds to the claimed invention, or that whatever commercial success may have occurred is attributable to the product or process defined by the claims. Ex parte Standish, 10 USPQ2d 1454, 1458 (Bd. Pat. App. & Inter. 1988).

Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in Graham M. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-13 and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Refuah et al. (WO 99/39281) in view of either reference U or reference V, cited in this action. Refuah is considered to disclose the claimed method comprising:

(a) collecting emotional orientation information obtained from a potential consumer based on an immediate individual emotional preconscious response (persona information collected through questionnaire and browsing activity or preference see pp 18-20) of the consumer according to emotional orientations (page 4 lines 21-22 wherein the disclosed site obtaining user persona and/or mood is considered patentably equivalent the claimed consumer

Art Unit: 3622

emotional information collection because both gather information relating to a persona, mood, and/or emotional state);

(b) storing the emotional orientation information of the consumer in a personal character profile record in a database, wherein the personal character profile record includes a value indicative of the emotional orientation of the consumer (page 4 lines 28-29 wherein the disclosed computer user personality storage is considered to anticipate the claimed consumer emotional orientation storage because personality determines emotional orientation);

(c) determining, based on the stored emotional orientation information in the personal character profile record, a predominant tendency of the consumer toward one individual emotional orientation (page 6 lines 27-34 wherein the disclosed mood update implicitly teaches the claimed consumer predominant emotional orientation determination because the updating disclosure implies a comparison between a stored value and current value and because a mood defines an emotional orientation of a user);

(d) sorting the character profile record in the database into clusters, wherein each cluster corresponds to a subset of character profile records determined to have a predominant tendency toward one of the individual emotional orientations (page 7 line 31 through page 8 line 10 wherein the disclosed parameter organization is considered to expressly anticipate the claimed cluster character profile sorting because a persona or character profile are both organized or sorted by predominant tendencies, such as the disclosed baseball interest or garish color scheme);

(e) determining, based on the predominant tendency toward the one of the individual emotional orientations of the cluster of the character profile record of the potential consumer, an appropriate marketing campaign directed to the specific cluster including the personal character

Art Unit: 3622

profile record of the potential consumer having a particular emotional orientation (page 9 lines 8-12 wherein the disclosed personal tailored advertisement is considered to be the same as the claimed appropriate marketing campaign determination because both target a promotion or incentive towards a consumer user based on mood, persona, and/or emotional orientation) for allowing said appropriate marketing campaign to be conveyed to the potential consumer (pp 9 lines 7-30, pp 24 lines 16-25; and

(f) displaying the determined marketing campaign to the potential consumer or outputting a determined matched other user to a user (page 15 line 5 wherein the disclosed interactor advertisement presentation is considered an identical function, method, and purpose as the claimed consumer marketing campaign display or user outputting because both compare consumer emotional or mood information with promotional incentive information for displaying, outputting, or presenting marketing or advertisement information).

Refuah is considered to also disclose the claimed questionnaire; wherein the questions relating to unique features (page 29 line 21), interactive medium including the Internet (page 6 line 16) or telephone (page 6 line 1), unique features (page 7 line 30), degree of cluster combination (page 7 line 34), and consumer stimulus response (page 4 line 13). Refuah teaches allowing information on said computer-determined matched other user to be conveyed to the user (see pp. 30 lines 12-18).

Refuah is considered to disclose the claimed invention except of the claimed value of one of a survival type, growth type, relaxation type, and a combination thereof, in the bolded text highlight of each of those references. In reference U, the disclosed fun and excitement category is considered to directly correspond to the claimed growth type, the disclosed relaxation and

Art Unit: 3622

stress removal category is considered to directly correspond to the claimed relaxation type, and the disclosed trust and safety category is considered to directly correspond to the claimed survival type. In reference V, the disclosed fun and excitement emotional shopper is considered to directly correspond to the claimed growth type, the disclosed stress reduction emotional shopper is considered to directly correspond to the claimed relaxation type, and the disclosed family welfare, trust and safety emotional shopper is considered to directly correspond to the claimed survival type. It would have been obvious to one skilled in the art to combine the teachings of Refuah with either reference U or reference V, for the purpose of distinguishing categories, clusters, or emotional shopper designations for targeted advertising.

Response to Arguments

Applicant's arguments filed September 28, 2005 have been fully considered but they are not persuasive.

In response to the non-final office action (mailed 11/3/04) applicant submitted a research report with a DECLARATION under 37 C.F.R. §1.132 to overcome the Requirement for Information Under 37 C.F.R. § 1.105. Examiner after reviewing the information then withdrew the "105" requirement and addressed applicant's argument in regard to the "103" rejection and made the rejection final. Applicant new claims the research submitted with the DECLARATION under 37 C.F.R. §1.132 (mailed 4/4/05) is a Declaration showing Commercial Success, as an important evidence of secondary considerations. Applicant further states that the Declaration has not been indicated to be properly considered by the Examiner in the Final Office Action. Applicant also states that the Examiner's 35 U.S.C. 103(a) rejection is inappropriate for failing to establish a prima facie case of obviousness, and should be withdrawn.

In regard to applicant's argument that specifying the claimed immediate individual emotional response as preconscious one which is distinguishable from and, from the marketing view point, more accurate than the references' cognitive response, Applicant's specification states, in page 6, that when an individual is exposed to a new advertisement, the first immediate response to the advertisement is completely emotionally-based. This is because the center have processed the information received. The thinking parts of the brain, after a few seconds, produce a response that rationalize and justifies the initial emotional response of the individual. A second rational response may occur that causes the individual to change their first rational response. Usually, however, this does not occur. Therefore, an individual's rational reaction to a new advertisement will tend to support the initial emotional response. The means that to companies marketing products or services, it is utmost important that the immediate emotional response is a positive one. The more positive the initial response, the more likelihood that the potential consumer will later make the decision to by the product or service. Applicant's specification states that according to the present invention, potential consumers can be categorized according to the following three basic character dispositions for the purpose of marketing: a) survival b) growth, and c) relaxation. Nowhere in applicant's specification does it disclose that the information to be obtained from the potential consumer is the one that is produced by the limbic system, which is based on immediate emotional preconscious response.

Applicant's specification discloses collecting information obtained from user for generating a computerized database containing personal character profiles of the potential customer (see page 3), analyzing and sorting the character profiles into at least three clusters (see

Art Unit: 3622

page 4). Then on page 4, the disclosure teaches, according to one embodiment the information is collected via questionnaire, the questionnaire containing questions relating to the level of disposition of the potential consumer towards survival, growth and relaxation. On page 12, the disclosure teaches responses to a questionnaire received over the WWW, e-mail, telephone, etc, further it teaches that alternatively it can be done through checking which internet sites an individual frequencies, spending patterns, etc, the questionnaire may contain questions concerning vacation preferences responses in hypothetical situations, and even favorite colors, all these can be indicative of whether the potential consumer is chiefly oriented towards survival, growth or relaxation. Further it discloses that the information collected is input into a database and each potential consumer is given a character profile and grouped into as cluster, according to the orientation manifested in the character profile.

The prior art also teaches collection information through questionnaire containing questions concerning vacation preference, favorite colors etc., or by checking which Internet sites an individual frequencies, which is an immediate emotional response (see pp 10 line 10 to pp 11 line 30, pp 12 lines 9-26, pp 13-15, pp 23 lines 12-14, pp 28 lines 1-19, pp 29 lines 21 to pp 31 line 25).

The prior art teaches displaying advertisement on a computer-driven display based on user's persona, for example when user's is working at home or office (pp 28 line 22 to page 31 line 9).

Applicant also argues that the 35 U.S.C. 103(a) rejection is traversed because the Examiner has failed to specify with reasonable clarity how the references or the knowledge generally available in the art supply the Examiner's suggestion or motivation to combine.

Art Unit: 3622

Applicant states that Applicant is not persuaded that the prima facie case of obviousness has been established. Examiner provided the motivation to combine the teaching of both prior art. Refuah teaches providing personally tailored service e.g., a new site providing happy news for an “up-beat” persona and depressing news to a “pessimistic” personal, or a site tailor searches performed to the personality, the regular interests of the user (a business mood will be greeted mainly with a business news and a business related advertisement). Refuah teaches personalizing advertisements responsive to a mood and/or persona. The personalization of advertisements in addition to or alternatively to personalization responsive to a particular search and/or other actions performed by the user at a site (see page 4). Refuah also teaches providing standard questionnaire to clients or a program may be loaded to track Internet usage pattern (pp 29) however does not indicate the emotional orientations according to at least one of survival type, growth type, relaxation type and a combination thereof. The U and V reference teaches values indicating the emotional orientation of the customer. The U and V reference teaches a broad study based on answers from 9,000 consumers in 23 markets reveling that shopper classify themselves as emotional buyers, logical shoppers and mixed of all those emotions. The emotional shoppers divided into three categories; those motivated by fun and excitement; those influenced by relaxation and stress removal; and those concerned with trust and safety issues. The reference teaches that the survey not only concludes that “emotional retailing” is a viable strategy for all types of retailers, but that retailers who focus on emotional shoppers enjoyed sales averaging 38 percent higher than their competitors. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the emotional retailing taught in the U and V references in Refuah personalized Internet interaction since concentrating

Art Unit: 3622

on the emotional orientation of the customer allows retailer to know the target customers and their expectations for the intended use of providing targeted or personalized advertisement or interaction.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YR


RETTA YEHDEGA
PRIMARY EXAMINER